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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/998,115	11/30/2001	Nitya Anand	RLL-193US	4448

26815 7590 09/04/2003

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EXAMINER

BERNHARDT, EMILY B

ART UNIT	PAPER NUMBER
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1624

10

DATE MAILED: 09/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/998,115

Applicant(s)

ANAND et al.

Examiner

Emily Bernhardt

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (e). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 5/9/03.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1, 3, 5, 6, and 8-10 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 5, 6, and 8-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:

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**In view of applicants' response filed 5/9/03 the following applies.**

**The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.**

**Claims 1,3,6,9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ishizumi (US'078 or ref.C5) for reasons of record. Note that claim 8 (method claim) was inadvertently rejected in the previous action.**

**Process claim 10 should have been included instead since this process is also taught by both Ishizumi references. See route C in col.3 of the US patent or route B on first page of ref. C5. While applicants have narrowed the scope of phenyl substituents in claim 1, benzyl (as R) is still embraced which is also included in US Ishizumi as well as the substituted phenyl species still present in independent claim 3. Note the preferred embodiments in col.1, last paragraph, through col.2, lines 1-3 include butylene and propylene derivatives with substituents on piperazine terminus that includes benzyl and phenyl substituted with alkyl, halo, alkoxy and trifluoromethyl which includes many of the species in claim 3. Also see claim 1 of US'078 Applicants' traverse to this rejection is directed to the fact that the prior art does not teach the same**

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**use/activity as relied on herein. The fact that the prior art teaches a different use is irrelevant in rejecting compound/composition claims. The discovery of an additional property does not make otherwise obvious compounds unobvious. Applicant must prove that their compound(s) possess a property that the prior art compound(s) do not possess- not is not disclosed to possess. See In re Best 195 USPQ 430; In re Shetty 195 USPQ 753 and In re Dillon 16 USPQ 2d 1897.**

**Claims 1,3,6,9 and 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

**In reviewing the Markush language for R it is noted that “(dihalodiphenyl)methyl” could be construed as a substituent on phenyl yet specification recites “and trifluoroalkoxy group” followed by “or (dihalodiphenyl)methyl” . Clarification of the claim language consistent with the specification (p.8) and compound 19 is thus needed.**

**Refs. C13 and C16 remain not considered for reasons given in previous action.**

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Any inquiry concerning this communication should be directed to Emily Bernhardt at telephone number (703) 308-4714.

A facsimile center has been established for Group 1600. The hours of operation are Monday through Friday, 8:45 AM to 4:45 PM. The telecopier numbers for accessing the facsimile machine are (703) 308-4556 or (703) 305-3592.

*F Bernhardt*  
**EMILY BERNHARDT**

**PRIMARY EXAMINER**

**GROUP 1600**